

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-76 are pending in the application.

Claim Rejection under 35 U.S.C. § 103

Claims 1-76 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shum, et al. in view of Li, et al. The Office does not specifically identify which Shum reference is being cited in this Action, and there are at least three patents naming Shum that are currently of record in this application. Based on the citations made in the Response, it appears that the Office is relying on U.S. 6,476,805 to Shum et al., which was relied on in the previous Action. Accordingly, the comments below assume that the rejection is U.S. 6,476,805 to Shum et al. (hereinafter, "Shum") in view of Li, et al. (U.S. Patent 6,567,081; hereafter "Li").¹

Applicant respectfully traverses this rejection, and further requests that this rejection be reconsidered and withdrawn.

Applicant submits that the rejection should be withdrawn because both of the references relied upon by the Examiner do not constitute prior art for 35 U.S.C. §103 purposes. This is made clear by 35 U.S.C. §103(c), which was amended effective Nov. 29, 1999 (Public Law 106-113) and states that:

Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section

¹ It is noted that the other two Shum patents—US 6,639,596 and US 6,750,860—also follow the same fact pattern set forth for the '805 patent in that they potentially qualify as prior art only under §102(e), and are commonly owned with the subject application by Microsoft Corp.

1 where the subject matter and the claimed invention were, at the time
2 the invention was made, owned by the same person or subject to an
3 obligation of assignment to the same person.

4 Applicant's current application was filed March 19, 2001. Shum and Li
5 were filed in 1999 and 2000, respectively, and did not issue as patents until June
6 15, 2004 and May 20, 2003, respectively. Therefore, Shum and Li could only
7 potentially qualify as prior art under §102(e).

8 Furthermore, Shum, Li, and the current application were "at the time the
9 invention was made, owned by the same person or subject to an obligation of
10 assignment to the same person," namely Microsoft Corporation. §103(c) (2004).
11 This common assignor, coupled with the reference's §102(e) classification, places
12 these references within the authority of 35 U.S.C. §103(c). Accordingly,
13 Applicant respectfully submits that neither Shum nor Li qualify as prior art for 35
14 U.S.C. §103(a) purposes, and that the rejection of all claims 1-76 should be
15 withdrawn.
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Conclusion

Claims 1-76 are in condition for allowance. Applicant respectfully requests prompt allowance of the subject application. If any issue remains unresolved that would prevent allowance of this case, **the Examiner is requested to contact the undersigned attorney to resolve the issue.**

Respectfully Submitted,

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